

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant(s): Robertson, et al. | |
| Application No.: 10/601118 | Art Unit: 3623 |
| Filed: 6/23/2003 | Examiner: R. David Rines |
| Title: Risk Classification Methodology | |
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APPLICANTS' REPLY TO EXAMINER'S ANSWER

Attached hereto is the Applicants' reply to the Examiner's Answer dated 2/5/2010.

REPLY

Oral Hearing

The Applicants are including herewith a "Request for Oral Hearing" in the present appeal. That document also requests that payment of the appropriate fee under 37 C.F.R. 41.20(b)(3) be charged to the agent's USPTO deposit account 502,083 if not otherwise paid and that all necessary additional fees (except the Issue Fee) be charged to and all refunds be credited to the same USPTO deposit account .

Examiner's Answer to Applicants' Appeal Brief

Amended rejection 35 U.S.C. § 112 first paragraph

The Examiner has added the following additional commentary to the rejection of claims 37-39 and 44-46 under 35 U.S.C. § 112 first paragraph.

Further, Examiner notes that any survey method, applied with due experimentation, could enable a user to make and use questions producing 5% level of confidence. However, there is insufficient written description of any more than 4 questions of such correlative value being produced by the disclosed method. There is further no evidence that the correlative value of the 4 questions is directly attributable to the claimed method nor would any more than the disclosed 4 questions be evident absent undue experimentation by a practitioner of the method. (Examiner's Answer, page 5)

Amended rejection 35 U.S.C. § 112 second paragraph

The Examiner has added the following additional commentary to the rejection of claims 37-39 and 44-46 under 35 U.S.C. § 112 second paragraph.

The claim limitation makes the assumption that the preceding steps will definitively produce 4 or more questions of the claimed correlative value.

Examiner submits that merely selecting 50 candidate questions and surveying 200 or more people will not ensure the generation of 4 or more questions of a 5% level of confidence each time the method is practiced. Accordingly, it is not clear how the intended effect of producing 4 or more questions is definitively achieved by the recited method steps. As claimed, the "significant.. . correlation" statement appears to convey an intended result. There is no indication of how this correlation is determined or why it would automatically occur based on the preceding steps. This limitation appears to convey an expectation rather than providing a positive recitation of methodology for obtaining a high correlation.
(Examiner's answer page 6)

Amended Rejection 35 U.S.C. § 103

The Examiner has amended the rejection of claims 37-39 and 44-46 under 35 U.S.C. § 103(a) to further note:

Haner discloses correlations made to insurance claims (Examiner's Answer, page 10)

This comment was made in the context of whether or not the Examiner has made a proper *prima facie* case of obviousness by asserting that Lajunen discloses step g of claim 37.

Applicants' Reply Arguments to Examiner's Answer

"Argument A" refers to the rejection of the claims under 35 U.S.C. § 103. The Examiner has characterized this rejection as being most relevant to the patentability of the presented claims. "Argument B" refers to the rejection under 35 U.S.C. § 112 first paragraph. "Argument C" refers to the rejection under 35 U.S.C. § 112 second paragraph. The Examiner has characterized this rejection as being the least relevant to the patentability of the presented claims.

Argument A – 35 U.S.C. § 103

Step g reads:

- g) *analyzing said information to select said set of four or more target questions from among said candidate questions such that the survey responses by said sample population to said set of four or more target questions significantly increase the multiple correlation between said survey responses and **said number of automobile insurance claims reported by said sample population** when said conventional classification information is controlled for, said increase in the multiple correlation being statistically significant to at least the 5% level of confidence; (emphasis added)*

The Examiner acknowledges that Lajunen does not perform any correlations with respect to automobile insurance claims. The "noting" by the Examiner that Haner does perform a correlation analysis with respect to insurance claims does not correct the defect in the Examiner's 103 analysis that Lajunen does not.

The Examiner asserts that the Applicants rely "exclusively" on the commentary provided by Dr. Nathan A. Thompson. This is factually incorrect and irrelevant to the persuasiveness of the Applicants' arguments. Reliance on an expert does not weaken the Applicants' arguments, it strengthens them.

Nonetheless, the Applicants did not need to rely on the declaration by Dr. Thompson to point out on pages 23 and 24 of the Appeal Brief, that there is an entire limitation of claim 37 the Examiner has failed to address in his 103 rejection. This limitation reads:

wherein said step of analyzing said information to select said set of four or more target questions is carried out on a particular computer modified to calculate multiple correlations and the levels of confidence thereof.

There was no need to support this observation by the declaration of Dr. Thompson since the Examiner's omission is self evident.

The Examiner further asserts that the Applicants' arguments with respect to claim 37 are "exclusively" directed to perceived shortcomings of one applied reference, Lajunen. This is also factually incorrect and emphasizes the Examiner's failure to provide a proper *prima facie* case of obviousness.

The Examiner's assertion is factually incorrect in the sense that the Applicants have pointed out that the Examiner has failed to show where numerous limitations of the claims under examination are not found in any of the prior art of record. The Applicants have directed their attention to Lajunen because this is where the Examiner has made the most errors in properly understanding the teachings of the prior art.

The Examiner, for example, has already acknowledged that that Haner "fails to disclose the distillation of four or more representative questions from a broad survey of 200 or more individuals" (Examiner's Answer pages 8 and 9). Thus there is no need for the Applicants to present arguments against disclosure by Haner where the Examiner has already conceded no disclosure exists.

The Examiner has noted that he "appreciates and agrees with Dr. Thompson's helpful commentary..." The Examiner then goes on to observe that Dr. Thompson's commentary is absent of any discussion or consideration of the teachings of the other art of record apart from Lajunen in light of the application. The Examiner then further notes that the rejection under appeal is not a 102 rejection and that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. The Examiner cites *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.1986). This commentary by the Examiner, however, merely underscores his failure to provide a *prima facie* case of obviousness.

The Examiner has asserted that certain limitations of the pending claims are found only in Lajunen. Dr. Thompson has provided his expert opinion that they are not. There is no need for Dr. Thompson to redundantly point out that these limitations are also not found in the other art of record.

Furthermore, *In re Keller* and *In re Merck* (citing *In re Keller*) are not germane to the current case since in both instances it was acknowledged that all of the limitations of the rejected claims were found in the prior art. That is not the issue in this case. The Examiner must show that each and every limitation is taught or reasonably suggested by the prior art before the burden shifts to Applicants to rebut the *prima facie* case of obviousness.

With respect to the dependent claims, the Examiner has stated that “the noted features are not relied upon by the Examiner as provided by the noted references...” (Examiner’s Answer page 17, emphasis added) The Examiner has admitted, therefore, that he has failed identify where each and every limitation of a claim is found in the prior art and his *prima facie* case of obviousness is dissipated.

The Examiner then summarizes his arguments for the rejection of the claims under 35 U.S.C. § 103. He concedes that Haner does not teach or reasonably suggest the specifics of the survey method claimed by the Applicants to select four or more target questions. He maintains that Lajunen corrects this defect by providing “general teaching of determining correlations...” (Examiner’s Answer page 18). He then maintains that “it would have been obvious to one of ordinary skill to select the inventories (of Lajunen) which provide the highest correlation to employ in the insurance determinations of Haner” (Examiner’s Answer page 19).

The “inventories” of Lajunen are single averages of multiple answers to multiple questions. They are not individual answers to individual questions as are required by the Applicants’ claimed invention. It would have been impossible for a person of ordinary skill in the art to perform the Applicants’ claimed correlations with respect to the individual questions in Lajunen since Lajunen did not disclose what his individual questions were.

Thus the Examiner has failed to provide a *prima facie* case of obviousness, has failed to set forth a proper rejection of claims 37-39 and 44-46 under 35 U.S.C. § 103 and must be reversed.

Argument B - 35 U.S.C. § 112 first paragraph

The Examiner reiterates his arguments regarding whether or not the current claims meet the requirements of 35 U.S.C. § 112 first paragraph.

The Examiner's additional commentary, however, continues to ignore the declaration provided by Dr. Thompson. Said declaration provides far more than "no evidence" that the Applicants were in possession of more than 4 questions at the time of filing.

The Applicants respond by observing that the Examiner has recognized and accepted the declaration of Dr. Thompson as authoritative. Dr. Thompson has stated that the Applicants were in possession of at least 5 questions as evidenced by the disclosure of the patent application in light of the knowledge of a person of ordinary skill in the art.

Dr. Thomson stated that the Applicants provided at least one additional question in the Specification which could be added to the minimum set of four "without compromising either the level of correlation or its statistical significance" (Thompson declaration, detailed answer to question 1). Four plus one is five. Five is greater than four.

Furthermore, the Applicants clearly stated that they regarded the four questions presented on page 4 of the Specification as illustrative and not exhaustive:

*...the following four survey statements are employed in **one version** of the questionnaire...*(Specification, page 4 line 3, emphasis added)

The Applicants also disclosed the desirability of adding redundant questions as anti-faking flags. See the section entitled "*Incorporating multiple questions directed to a particular trait*" on page 18 of the Specification. As many redundant questions could be added as needed.

Thus the Applicants provided a minimum of four questions with the experimentally verified correlative value, provided additional questions that anyone of ordinary skill in the art would recognize could be added to the minimal four to increase the number to greater than four, and provided instructions on how to add still more questions without compromising the correlative value of a set of questions as a whole.

Furthermore, claim 39 is limited to only four target questions, which the Examiner has conceded the Applicant was in full possession of. Yet the Examiner has still rejected this claim under 35 U.S.C. § 112 first paragraph.

Thus the Applicants were in full possession of the claimed invention at the time the application was filed , the Examiner has failed to set forth a proper rejection of claims 37-39 and 44-46 under 35 U.S.C. § 112 first paragraph and the Examiner must be reversed.

Argument C - 35 U.S.C. § 112 second paragraph

The Examiner has reiterated his arguments regarding whether or not the current claims meet the requirements of 35 U.S.C. § 112 second paragraph .

The Examiner's additional commentary, however, appears to misconstrue claim 37. Step g is part of the "wherein" clause which defines target questions as those that **have been** devised by the method comprising steps d through g. Thus there is no issue of whether or not steps d through g will produce the intended result. It has already been achieved.

The Examiner further disregards the declaration provided by Dr. Thompson when the Examiner states that "There is no indication of how this correlation is determined". Dr. Thompson indicated that a person of ordinary skill in the art understands what a "multiple correlation" is and how it's performed. There is no need to repeat these steps in the claim.

Thus the Examiner has failed to set forth a proper rejection of claims 37-39 and 44-46 under 35 U.S.C. § 112 second paragraph and must be reversed.

CONCLUSION

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mark Nowotarski, Applicants' Agent at 203 975 7678 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above arguments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

March 26, 2010

Respectfully Submitted,

A handwritten signature in cursive script that reads "Mark Nowotarski".

Mark Nowotarski
Attorney/Agent for Applicant(s)
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